

Appl. No. 10/003,219

Reply to Office Action of September 3, 2003

REMARKS

This amendment is responsive to the Office Action dated September 3, 2003. Applicants have amended claims 8 and 22 and have canceled claim 10. Claims 1-9 and 11-24 are pending.

Claim Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 8-9, 11-13, and 22-24 under 35 U.S.C. § 102(b) as being anticipated by Akiyama (U.S. Pat. No. 5,815,342). The Examiner further rejected claims 8, 11, 12, 13, and 22 under 35 U.S.C. § 102(b) as being anticipated by Lal et al. (U.S. pat. No. 5,576,085).

Applicants assert that amendments to claims 8 and 22 put all pending claims in condition for allowance.

Claims 8-9, and 11-13

The Examiner objected to claim 10 as being dependent upon a rejected base claim. Claim 10 would be allowable, said the Examiner, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants have amended independent claim 8 to recite the limitations of claim 10 and have cancelled claim 10. This is equivalent to rewriting claim 10 in independent form including all of the limitations of claim 8. Claim 8 is therefore in condition for allowance.

Claims 9 and 11-13 are dependent upon claim 8. Because claim 8 is in condition for allowance, claims 9 and 11-13 are in condition for allowance as well.

Claims 22-24

Applicants note that, in regard to claims 22-24, the Examiner's Office Action is terse and does not "present a full and reasoned explanation of [the] decision," as required by *In re Lee*, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002). "This standard requires that the agency not only have reached a sound decision, but have articulated the reasons for that decision." *Id.* at 1433. In particular, the Examiner did not make any effort to demonstrate how the cited references anticipate Applicants' claims 22-24.

Appl. No. 10/003,219

Reply to Office Action of September 3, 2003

Although the Examiner's decision did not specifically describe how Akiyama and Lal et al. anticipate claims 22-24, Applicants have amended claim 22 in a way that clarifies claim 22. In particular, Applicants have amended claim 22 to recite "regulating the shape of the transition width of the recording field." With this clarification, Akiyama and Lal et al. are clearly distinguishable from Applicants' claimed invention.

As set forth in Applicants' disclosure, e.g., page 8, lines 1-3 and 23-26, Applicants' claimed method affects transition width broadening. As described in Applicants' disclosure, Applicants' claimed method affects the shape of the recording field by affecting the field gradient. As noted on page 7, lines 2-4 and 11-12, the gradient of a conventional field broadens as the field penetrates the medium. By application of the method recited in claim 22, as amended, transition width broadening is reduced, as noted on page 8, lines 1-3 of Applicants' specification.

Neither Akiyama nor Lal et al. teaches or suggests regulating the shape of a transition width of a recording field with a permeable magnetic underlayer, as recited in claim 22, as amended. Claims 23 and 24 depend upon claim 22. Applicants submit that the amendment to claim 22 places claims 22-24 in condition for allowance.

Allowed Claims

The Examiner allowed claims 1-7 and 14-21.

Furthermore, Applicants have amended independent claim 8 to recite the limitations of claim 10, and has cancelled claim 10, thereby placing claim 8 in condition for allowance.

Appl. No. 10/003,219

Reply to Office Action of September 3, 2003

CONCLUSION

All claims in this application are in condition for allowance. Applicants respectfully request reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

12/1/03

Imation Corp.
1 Imation Place
Oakdale, MN, 55128
Tel (651) 704-3604
Fax (651) 704-5951

By:



Name: Eric D. Levinson
Reg. No.: 35,814